



PATENT
Docket No. 220002057121
Client Ref. 94-161-4

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231, on December 22, 1997.

Date

12-22-97

Michelle Fissel

Michelle Fissel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

H. Kirk Hammond, Frank J. Giordano and
Wolfgang H. Dillmann

Serial No.: 08/722,271 (U.S. National Phase
of PCT/US96/02631)

For: GENE TRANSFER-MEDIATED
ANGIOGENESIS THERAPY

International Filing Date: February 27, 1996

Examiner: Not yet assigned

Group Art Unit: Not yet assigned

RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)

Assistant Commissioner for Patents
Washington, D.C. 20231

Attn: PCT Legal Office

Dear Sir:

Reconsideration of the Petition Under 37 CFR §1.47(a) is hereby requested. A petition was filed on March 18, 1997 to request that co-inventor H. Kirk Hammond be allowed to make application for patent on behalf of himself, co-inventor Frank J. Giordano (who refuses to sign any of the papers related to this application), and co-inventor Wolfgang H. Dillmann (who has signed the Assignment but refuses to co-sign the Inventor's Declaration on behalf of Dr. Giordano). Such action is necessary to preserve the rights of the parties and to prevent

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irreparable damage, by allowing the parties to complete the requirements for filing under 35 U.S.C. § 371 and to continue with prosecution of the patent application. A Decision issued by the PCT Legal Office on July 22, 1997, dismissed the Petition on grounds that not all the requirements under 37 CFR §1.47(a) have been satisfied.

Specifically, the Decision indicated that the following items need to be provided:

- 1) A Declaration by each 37 CFR §1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor;
- 2) Demonstration that a bona fide attempt was made to present a copy of the application papers (specification including claims and drawings, and declaration) to the non-signing inventor for signature;
- 3) Evidence on a firsthand knowledge basis, of the efforts made to secure the signature of Dr. Dillmann on behalf of himself and the non-signing co-inventor, Dr. Giordano;
- 4) Declaration of facts stating the reason why a non-signing inventor is refusing to sign the application papers, if a reason is given; and
- 5) Statement of the last known address of Dr. Dillmann.

This renewed Petition is submitted to address the aforementioned deficiencies in the previous Petition.

With regard to item 1) above, a new inventor's Declaration executed by inventor H. Kirk Hammond, on behalf of himself and of the non-signing co-inventors, is submitted herewith.

With regard to item 2), the accompanying declaration of facts by Virginia de la Puente and exhibits attached to the declaration, document a bona fide attempt to present a copy of the complete application including the claims and drawings, and a copy of the inventor's Declaration, to each of the non-signing inventors, Dr. Giordano and Dr. Dillmann. Exhibits A and B, and Exhibits D and E document the presentation of the application papers to Dr. Giordano and Dr. Dillmann, respectively.

Efforts made to secure Dr. Dillmann's signature on behalf of Dr. Giordano, and any reasons given by the non-signing inventors for their refusal to sign the application papers (Item 3 and 4 above) are documented in the declaration of facts by Virginia de la Puente, specifically in paragraphs number 7-10.

With regard to item 5), the last know address of each of the non-signing inventors is as follows:

Frank J. Giordano
13119 Caminito Mar Villa
Del Mar, California 92014

Wolfgang H. Dillmann
355 S. Nardo Beach
Solano Beach, California 92075

With this renewed Petition accompanied by a new inventor's Declaration executed by H. Kirk Hammond, as well as the declaration of facts and exhibits, the undersigned submits that all requirements for the Petition under §1.47(a) have been satisfied. Accordingly, it is requested that the above-referenced application be granted status under 37 CFR §1.47(a) as soon as possible.

The Decision on the Petition indicated that no additional fee is required for this renewed petition. However, if additional fees are due, please charge any additional fees, or credit any overpayment in connection with this communication, to Deposit Account No. 03-1952 (ref. 22000-2057121).

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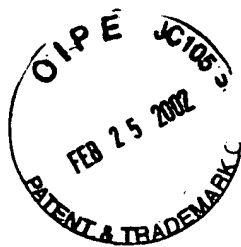
Group Art Unit: Not yet assigned

DECLARATION OF FACTS IN SUPPORT OF FILING ON
BEHALF OF NAMED INVENTORS (37 C.F.R. § 1.47)Assistant Commissioner for Patents
Washington, D.C. 20231

Attn: PCT Legal Office

Dear Sir:

This declaration is made as to the facts that are relied upon to establish the diligent effort made to secure the execution of the inventors' declaration by the named co-inventors, Frank J. Giordano and Wolfgang H. Dillmann, for the above-identified patent application. This declaration is made by a person having first-hand knowledge of the facts recited herein.

**I. IDENTIFICATION OF PERSON MAKING THIS DECLARATION OF FACTS**

Virginia de la Puente
12575 Brookpark Road
Oakland, CA 94619

II. LAST KNOWN ADDRESS OF THE NAMED INVENTORS WHO HAVE REFUSED TO SIGN THE APPLICATION PAPERS

Second named inventor: Frank J. Giordano
13119 Caminito Mar Villa
Del Mar, California 92014

Third named inventor: Wolfgang H. Dillmann
355 S. Nardo Beach
Solano Beach, California 92075

III. DETAILS OF REFUSAL OF INVENTORS GIORDANO AND DILLMANN TO SIGN APPLICATION PAPERS AND EFFORTS TO OBTAIN INVENTORS' SIGNATURES

1. I am a Licensing Associate of the Office of Technology Transfer for the University of California, at 1320 Harbor Bay Parkway, Suite 150, Alameda, California 94502.

2. Since at least as early as January 20, 1995, I have been responsible for overseeing the filing, prosecution and licensing of a family of applications which includes the above-identified application.

3. The following facts relate to Dr. Frank J. Giordano's refusal to sign both the Inventor's Declaration (hereinafter referred to as "Declaration") and the Assignment for application Serial No. 08/722,271. On October 11, 1996, Wean-Khing Wong, the attorney from the firm of Robbins, Berliner & Carson, who was handling the case on behalf of the University of California at the time, sent copies of a Declaration and an Assignment to Dr. Giordano for his signature, along with a copy of the patent application as filed. A copy of this letter is attached

hereto as Exhibit A. To this date, neither I nor the law firm of Robbins, Berliner & Carson have received the executed Declaration and Assignment from Dr. Giordano.

4. On February 7, 1997, I contacted Dr. Giordano by telephone and asked him whether he would sign the Inventor's Declaration for this U.S. application. Dr. Giordano stated that he would not execute the Declaration.

5. On September 5, 1997, I called Dr. Giordano and explained that in view of the Examiner's concern that he (Dr. Giordano) may not have been presented with a copy of the application papers, I would send him another copy of the patent application as filed, and the Inventor's Declaration, to ensure that he had another chance to review the application and to sign the Declaration. Dr. Giordano indicated in that telephone conversation that it was unlikely that he would sign the Declaration.

6. Following up on the telephone conversation of September 5, 1997, on September 12, 1997, I sent a letter to Dr. Giordano enclosing a copy each of the patent application including the claims and drawings, and the Inventor's Declaration. The letter and enclosures were sent by certified mail. A copy of the cover letter is attached hereto as Exhibit B. In the letter, I specifically requested that Dr. Giordano return the executed Declaration to me by September 19, 1997. To this date, I have not received the executed Declaration nor heard from Dr. Giordano.

7. Dr. Frank J. Giordano has indicated that his refusal to sign the application papers was related to his objection to the University of California's (the Assignee) decision with respect to the licensing agreement.

8. The following facts relate to Dr. Wolfgang Dillmann's refusal to sign the Declaration on behalf of Dr. Giordano. Dr. Dillmann had originally signed the Inventor's Declaration and assignment (executed documents previously submitted with the first Petition under Rule §1.47(a) and response to the Notification of Missing Requirements filed March 18,

1997). In the first petition filed March 18, 1997, it was indicated that Dr. Dillmann was unwilling to co-sign the petition. In view of Dr. Dillmann's position on the first petition, the Examiner raised concerns as to whether Dr. Dillmann willingly executed the Declaration on behalf of Dr. Giordano. In an effort to clarify his intent, I then tried to contact Dr. Dillmann by telephone on September 5 and 12, 1997, but was unable to reach him. I left him telephone messages but did not hear from him. On September 16, 1997, I did reach Dr. Dillmann by telephone and asked if he would execute a new Inventor's Declaration to indicate that he was signing on behalf of himself and Dr. Giordano. Dr. Dillmann replied that under no circumstances would he sign a Declaration on behalf of Dr. Giordano with whom he shares a laboratory.

9. On October 2, 1997, I sent Dr. Dillmann a letter (copy attached hereto as Exhibit C) restating the issues we had discussed over several telephone conversations regarding the Patent Office concerns over the intent of his Declaration. In the letter, I indicated that if he failed to contact me by October 8, 1997, I will assume that he wishes to be a nonsigning inventor.

10. Dr. Dillmann was previously sent a complete copy of the filed patent application by Wean-Khing Wong, the attorney from the firm of Robbins, Berliner & Carson, who was handling the case on behalf of the University of California at the time. A copy of the letter dated October 11, 1996, from Ms. Wong is attached hereto as Exhibit D. However, to further assure the Examiner that Dr. Dillmann did have an opportunity to review the complete application as filed and to sign the inventor's Declaration on behalf of Dr. Giordano, on November 5, 1997, I forwarded a copy of the application and Declaration to Dr. Dillmann's home address by certified mail. A copy of my letter of November 5, 1997 is attached hereto as Exhibit E. I received a return receipt indicating the safe arrival of the package at Dr. Dillmann's home. To this date, I have not heard from Dr. Dillmann with regard to the inventor's Declaration.

12-22-97 01:56PM FROM OFFICE OF TECH. TRAN TO 916504940792

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FROM MORRISON & FOERSTER LLP (650) 494-0792 (MON) 12. 22' 97 13:04/PT. 12:52/NO. 9760437034 P 6

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: December 22, 1997

Virginia de la Puente
Virginia de la Puente

Attachments:

- Exhibit A. Letter dated October 11, 1996 from Wean Khing Wong to Dr. Giordano, forwarding a copy of the patent application and Inventors' Declaration.
- Exhibit B. Letter from Virginia de la Puente to Dr. Giordano dated September 12, 1997, enclosing copy of the application and Inventors' Declaration.
- Exhibit C. Letter from Virginia de la Puente to Dr. Dillmann dated October 2, 1997, regarding Petition under 37 CFR 1.47(a) and Inventors' Declaration.
- Exhibit D. Letter dated October 11, 1996 from Wean Khing Wong to Dr. Dillmann, forwarding a copy of the patent application and Inventors' Declaration.
- Exhibit E. Letter from Virginia de la Puente to Dr. Dillmann dated November 5, 1997, enclosing copy of the patent application and Inventors' Declaration.